

Appln No. 09/785,643  
Amdt date March 21, 2006  
Reply to Office action of November 22, 2005

### REMARKS/ARGUMENTS

Claims 1-46 are pending. Claims 1, 5, 13, 19, 21, 33, 39, 41, and 43 are amended.

The Examiner has not acknowledged the IDS that was filed on June 24, 2005. Applicants respectfully request acknowledgment of the above-mentioned IDS by initialing and returning the attached copy of the same IDS.

Claims 1-12, 19-29 and 39-42 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,598,477 issued to Berson (hereinafter, "Berson") in view of U.S. Patent No. 5,621,797 issued to Rosen (hereinafter, "Rosen"). Claims 30-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Berson and Rosen as applied to claim 19 and further in view of U.S. Patent No. 6,233,565 issued to Lewis, et al. (hereinafter, "Lewis"); and claims 13-18, 33-38 and 43-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis, et al. (hereinafter, "Lewis") in view of Berson and Rosen.

Applicant respectfully submits that the rejections are improperly expressed and that the Examiner is engaging in (improper) piecemeal examination.

For example, in a first Office action dated 12/17/03, claims 1-46 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Lewis** (6,233,565) in view of **Berson** (5,598,477). In a response dated 3/16/04 applicants distinguished both Lewis and Berson and argued that **Berson teaches away** from the Applicant's method of validating a value bearing indicium, because in Berson "validation of the ticket is performed by using **only** the information included in the ticket, either automatically or by an operator. Only **after** the ticket has been validated does the validating system then download information to **reconcile** the ticket." (Page 4, middle paragraph).

In a Final Office action dated 4/19/04, claims 1-46 were again rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Lewis** in view of **Berson**. In a response dated 10/19/04 Applicant submitted that "[i]t is improper, as the Examiner has done here, to combine references that do not in combination disclose each and every feature of the claimed invention. It is further improper to piece together references when the references themselves, alone and in combination,

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fail to disclose or suggest such a combination." (Page 2, middle paragraph). The Applicants also stressed that Examiner had not responded to the argument that neither Lewis nor Berson, alone or in combination, discloses determining a validity status for the value bearing indicium data using the validation information database. (Page 2, last paragraph). More importantly, the Applicant emphasized that "**Berson teaches away** from the Applicant's method of validating a value bearing indicium," because "in Berson, a ticket is created having a field including sufficient information to enable automatic reconciliation of the ticket. The information may be fully encrypted or digitally signed. *Validation of the ticket is performed by using only the information included in the ticket, either automatically or by an operator. Only after the ticket has been validated does the validating system then download information to reconcile the ticket. There is no suggestion in Berson that the information used in reconciling the ticket is used to validate the ticket.* Instead, validation is a necessary precondition to accessing the information used during reconciliation." (Page 3).

Subsequently, in an Office action dated 12/22/04, the Examiner, without addressing Applicant's arguments, changed the rejection of claims 1-12, 14-15, 19-21, 24-29, 34-35, and 39-42 to **Berson** in View of **Rosen** (5,621,797). The Examiner acknowledged on page 4 of the Office action that **Berson** does not teach "determining a validity status for the value bearing indicium data using the validation information database" and "transmitting the validity status to the scanning machine" elements of independent claims 1, 19 and 39. However, the Examiner relied on **Rosen**, citing Col. 25, lines 15-67, as teaching these elements of the claims.

In a response dated 4/22/05, the Applicant argued that **Rosen** does not teach the above limitation and does not even refer to the use of a database in this process or the use of a scanner in the cited text. (Page 17). Applicant further argued that "one of ordinary skill in the art would not be motivated to **combine Rosen with Berson** in order to authenticate the validity of the value bearing indicium as *Berson* is already capable of this." (page 18).

In a subsequent Office action dated 6/6/05, the Examiner deemed the above-arguments persuasive and withdrew the rejections of claim 1-46. However, the Examiner rejected the relevant claims again based on the same combination of **Berson** and **Rosen**. The Examiner

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dismissed the "lack of motivation" argument because the references "are in the same field of invention ... and Rosen provides details not specifically taught by Berson but inferred." More importantly, the Examiner repeated, without any further elaboration and without addressing Applicant's argument, his reliance on **Rosen**, citing Col. 25, lines 15-67, as teaching the "determining a validity status for the value bearing indicium data using the validation information database" and "transmitting the validity status to the scanning machine" elements of the claims.

Applicants' attorney conducted an interview with the Examiner on 8/31/05. Applicant's attorney pointed out that Rosen does not teach the use of a database to check validity as argued by the Examiner in the Office action. Rather, Rosen teaches checking a status field in the ticket itself to determine validity. Applicant's attorney pointed to col. 25, lines 32-33 that provide the example of an event ticket that includes a "status field 100" that "indicates whether the ticket 8 has already been presented and is thus valueless." Applicant's attorney also pointed to Figure 2, which shows example tickets including an event ticket 88 that includes a status field 100. The Examiner acknowledged that it appeared from what the Applicant's attorney had pointed out, that indeed, Rosen did NOT teach the use of a database to check validity status of a ticket.

Applicant's attorney also requested clarification of the argument presented in support of the combination of **Rosen** and **Berson** in the third page of the Office action including the Examiner's argument rebutting Applicant's assertion that there is no motivation to combine because the Examiner "disagrees in that **Rosen** does in fact show the use of databases in the system describe in Fig. 1, i.e. DATA PROCESSING SYSTEM 12-1-12-N." Consequently, the Examiner acknowledged in the interview that **Rosen** does NOT show a data processing system in figure 1. Rather, the data processing system referred to by the Examiner is in Fig. 1 of **Berson**.

In a response dated 9/1/05 Applicants summarized the interview and again argued that **Rosen**, alone or in combination with **Berson**, does not teach or suggest "determining a validity status for the value bearing indicium data using the validation information database" and "transmitting the validity status to the scanning machine."

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The current Office action dated 11/22/05 is consequently issued rejecting the relevant claims again based on the same combination of **Berson** and **Rosen** and modifying the "use of **Rosen** for the rejection." Here, the Examiner goes back to **Berson** (col. 2, lines 10-20, and col. 4, lines 10-40) to reject the limitation of "determining a validity status for the value bearing indicium data using the validation information database" This by itself is an improper piecemeal examination because the Examiner has acknowledged in the 12/22/04 Office action that **Berson** does not teach "determining a validity status for the value bearing indicium data using the validation information database." MPEP 707.07(g) states that "piecemeal examination should be avoided as much as possible. The Examiner should reject each claim on all valid grounds available." The **Berson** reference was already acknowledged not to teach the above limitation.

Additionally, the rejections of claims 19 and 39 in the current Office action are improperly expressed rejections. MPEP 707.07(d) states that "[a] plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group." The current Office action fails to show how **Berson** and **Rosen** references are equally applicable to claims with regard to their additional limitations (other than the preamble).

Nevertheless and again, Applicants respectfully submit that **Berson** and **Rosen**, alone or in combination, do not teach or suggest the above-mentioned limitations.

For example, independent claim 1 is amended to include, among other limitations, "storing the value bearing indicium data in a validation information database, before the value bearing indicium is validated," "determining a validity status for the value bearing indicium data using the validation information database," and "transmitting the validity status to the scanning machine."

**First**, neither **Berson** nor **Rosen**, alone or in combination, teach or suggest "storing the value bearing indicium data in a validation information database, before the value bearing indicium is validated." The cited text of **Berson** (col. 2, lines 14-17) describes downloading at least a portion of the ticket information, "if the ticket is valid." (underling is added.). In contrast, the claimed invention stores the "value bearing indicium data in a validation

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information database, before the value bearing indicium is validated." Therefore, Berson does not teach the above limitation. Applicant respectfully disagree with the Examiner's assertion that "these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps cited. The step at issue includes the functional language of "storing in a database," and "before the value bearing indicium is validated." MPEP is very clear about functional limitations in a claim. Section 2173.05(g) defines a functional limitation as "an attempt to define something by what it does, rather than by what it is." Here, the above-mentioned step includes "storing in a database," and "before the value bearing indicium is validated," that is, what the invention does, rather than what it is. MPEP 2173.05(g) further states that "a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what is fairly conveys to a person of ordinary skill" in the art. Here, a person of ordinary skill in the art would easily recognize that storing in a database is different for example, from storing in a signal, storing in the data itself (as is the case in Berson), storing in a register, etc. Additionally, the limitation of "before the value bearing indicium is validated" is understood by a person of ordinary skill in the art to be a functional limitation that indicates when in the different stages of data processing, the data is being stored and the nature of the data being stored.

Similarly, in Rosen a "Ticket Holder B creates the ticket (step 468). Purchase B then sends the ticket to trusted agent A (steps 470-472). Purchase A receives the ticket and checks if it is correct by comparing the expected merchandise identity (previously received from the BTA) with information in the ticket (steps 474-476). If not correct, then Purchase A identifies the transaction as a purchase and hence aborts the transaction (steps 478-482). If trusted agent A approves the ticket as correct, it then sends information from the ticket to a host transaction application for purchaser confirmation (steps 486-488). Such information allows the CTD holder to verify that he is getting the merchandise and price that he previously selected. If the ticket information is not correct, then the transaction is aborted (steps 478-482). If the ticket is correct, then Purchase A sends the ticket to Ticket Holder A for storage (steps 490-492)." (Col. 18, lines

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62-67, underlining added.). Therefore, Rosen like Berson, only stores the ticket if the ticket is validated.

Accordingly, Berson and Rosen, alone or in combination, do not teach or suggest "storing the value bearing indicium data in a validation information database, before the value bearing indicium is validated."

**Second**, neither Berson nor Rosen, alone or in combination, teach or suggest "determining a validity status for the value bearing indicium data using the validation information database." Again, as explained in the previous Responses, Berson validates a ticket based on the information included in a field within the ticket. That is, Berson does not use any database or for that matter, any data other than the data included with the ticket itself. In fact, in Berson's system, the created ticket includes a field that has encrypted data used for validation of the same ticket. There is no teaching in Berson that the data for validating a ticket is retrieved from somewhere else other than the ticket, for example, a database. In fact, by storing all the necessary validation information within the ticket itself, **Berson teaches away** from "determining a validity status for the value bearing indicium data using the validation information database."

Similarly, Rosen checks a "status field 100" in the ticket itself to validate the ticket. See, for example, cited text (col. 25, lines 15-67, specifically, lines 32-33) of Rosen. Indeed, by storing all the necessary validation information within the ticket itself, **Rosen teaches away** from "determining a validity status for the value bearing indicium data using the validation information database." Consequently, Berson and Rosen, alone or in combination, do not teach or suggest "determining a validity status for the value bearing indicium data using the validation information database."

**Third**, neither Berson nor Rosen, alone or in combination, teach or suggest "transmitting the validity status to the scanning machine." Again, Berson teaches downloading at least a portion of the validating ticket to off-line Store 28, or downloaded directly to data processing system 12-1. (Col. 4, lines 33-36). This is not the same as transmitting the validity status to the scanning machine where the value bearing indicium data was received via a computer network.

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Similarly, there is no mention of transmitting the validity status to a scanning machine via a computer network in Rosen. Accordingly, Berson and Rosen, alone or in combination, do not teach or suggest "transmitting the validity status to the scanning machine."

**Fourth**, one of ordinary skill in the art would **not be motivated to combine Rosen with Berson** in order to authenticate the validity of the value bearing indicium, because Berson already authenticates the ticket using the information contained in the ticket. In other words, with respect to validating tickets, each of the Berson and Rosen references is complete and functional in itself thus, there would be no reason to use parts from or add or substitute parts (or functionality) to any of them.

In short, the amended independent claim 1 defines a novel and unobvious invention over the cited references. Thus, independent claim 1 is allowable over the cited references. Amended independent claims 13, 19, 33, 39 and 43 include similar limitations and additional limitations therein. Therefore, these claims are also allowable over the cited references, as including allowable limitations and for the additional limitations they include therein.

Amended **dependent claims 5, 21, and 41** include "wherein the validity status of the value bearing indicium data is determined to be redeemed if the value bearing indicium data and a redemption status thereof are found in the validation information database." Berson and Rosen, alone or in combination, do not teach or suggest the above limitation. Applicant respectfully disagrees with the Official Notice taken by the Examiner deeming the above limitation obvious. First, MPEP 2144.03 (B) requires that "if Official Notice is taken of a fact, unsupported by documentary evidence, the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable. Here, the reasoning is not clear and unmistakable because storing a redemption status in a validation information database, determining the validity status of the value bearing indicium to be redeemed if the value bearing indicium data and a redemption status thereof are found in the validation information database is not well-known in the art. Consequently, Berson and Rosen, alone or in combination, do not teach or suggest "wherein the validity status of the value bearing indicium data is determined to be redeemed if the value bearing indicium data and a redemption status thereof are found in the

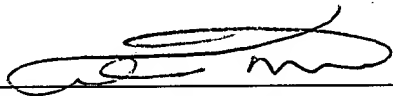
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validation information database," and thus **dependent claims 5, 21, and 41** are also patentable over the combination of Berson/Rosen as being dependent from allowable independent claims and for the additional limitations they include therein.

The remaining dependent claims 2-4, 6-12, 14-18, 20, 22-32, 34-39, 40, 42, and 44-46 are dependent from claims 1, 13, 19, 33, 39 and 43 respectively and include all the limitations of their independent claims and additional limitations therein. Accordingly, these claims are also allowable over the cited references, as being dependent from allowable independent claims and for the additional limitations they include therein.

In view of the foregoing amendments and remarks, it is respectfully submitted that this application is now in condition for allowance, and accordingly, reconsideration and allowance are respectfully requested.

Respectfully submitted,  
CHRISTIE, PARKER & HALE, LLP

By   
Raymond R. Tabandeh  
Reg. No. 43,945  
626/795-9900

RRT/clv

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